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REMARKS

Reconsideration of the above referenced application in view of the enclosed amendments and remarks is requested. Claims 27-28 have been added. Claims 1-28 remain in the application.

ARGUMENT

Claims 1-5, 7-19, and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. 6,496,851, issued to Morris (hereinafter Morris).

As to claim 1, it recites the following two elements: 1) receiving a dedication from a first user via a network; and 2) applying the dedication to a play list. It is a fundamental principle of claim interpretation that an applicant can be his or her own lexicographer.

The term "dedication" is defined in the Specification at page 3, lines 12-17:

"As used herein, 'dedication' refers to any media content specified by a party other than the user experiencing the content. In one sense, network-based dedications are similar to the familiar radio dedications in which a friend or family member contacts the radio station and requests that a particular song 'go out to X', where X is a listener of the radio station."

Thus, a dedication is used by a first user to identify or specify media content (such as a song stored in a digital form on an accessible storage device) that the first user desires to be sent to or accessed by and rendered for perception by a second user. The dedication may be either an identifier of the media file (such as a URL or other path name of the media file) or it may be the media file itself (i.e., an MP3 file containing a song). Typically, the perception of the dedication by the second user will occur in the context of an Internet radio application using a browser, or during the playing of media files by a media player application.

In the Office action of April 28, 2003, the Examiner purports to find this concept of a "dedication" in Morris. Morris teaches of a system whereby two on-line users can interactively negotiate between themselves to set up a subsequent joint on-line activity. In the system taught by Morris, a first user proposes an activity,

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such as a chat session or on-line game, to a second user. The second user responds to the proposal by either accepting it or varying the parameters of the proposal to create a counter-proposal. Morris helps online users produce an optimal environment for an activity by enabling them to negotiate parameters of the activity until agreement is reached. Morris teaches or suggests nothing about play lists, media players, or dedications.

The Examiner has interpreted "dedication" excessively broadly to include a request to chat with a user, a request to transfer a file to a user, or a request to play a game with a user. Apparently, Morris teaches about arranging for a chat session, transferring files, and playing on-line games, all between two negotiating on-line users. *However, Morris teaches or suggests nothing about a dedication as defined in the present Specification.* As defined in and used in the context of the Specification, a "dedication" is media content (e. g., a song or video) to be inserted into a play list of media files of *another* user. The insertion of the dedication into the play list is a unilateral act, not requiring active participation on the part of the second user (i.e., the owner of the play list). In fact, rendering of the dedication would probably be a surprise to the second user. The familiar idea of a radio dedication has never been heretofore contemplated for the computer user who has access to media players, browsers, personal play lists, and on-line and off-line digital music. The invention embodied in claim 1 is not taught or suggested in Morris, and the Examiner has strained to read "dedication" so broadly as to encompass requesting a chat session or playing a game as taught by Morris, as stated in footnote 1 of the Office action. This is an erroneous claim interpretation that cannot stand. Claim 1, all claims dependent therefrom, and all claims reciting the term "dedication" that are rejected under Morris on this basis, are allowable as presented.

Further, the Examiner admits in the Office action that Morris does not teach or suggest applying the dedication to a play list of a second user. The Examiner goes on to contend that Morris' teaching of "applying instant messages to an applet could be considered a play list." This is an incorrect interpretation.

The term "play list" is described in the Specification at page 2, line 30 to page 3, line 5:

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"Users are experienced in using audio player applications to build play lists of their favorite music. Play lists are a feature of many of the available audio player applications. A user typically constructs a play list of multiple units of audio content (e.g., music files) obtained from a variety of sources. Collectively, the content of the play list may be referred to as a "program". The individual units of content which make up the play list may be referred to as "segments" of the play list."

As described in the Specification, a "play list" is clearly a list of multiple units of audio content. This audio content is rendered for perception by a user in a sequence according to the play list by a media player application. The Specification also states that "it should be appreciated that the topics may apply to video and other forms of media content as well." (See Specification page 2, lines 28-29).

The Examiner strives to impermissibly expand the ordinary meaning of the term "play list" to mean an applet (i.e., a program or software code) providing functionality to support users chatting or playing a game on-line (as stated in footnote 2 of the Office action). However, the term "play list" is commonly understood by those skilled in the art (as well as by millions of ordinary consumers using media players and the Internet) to mean a list of files that can be rendered by a media player (e.g., an MP3 file playable by Windows Media Player). The Examiner's overreaching expansion of the term cannot be supported. It is contradictory to how the Applicants have described and used the term, as well the common understanding of millions of consumers. Morris does not teach or suggest anything about applying a dedication to a play list, and the Examiner has admitted this in the Office action. Yet, the Examiner struggles to greatly expand the meaning of the term "play list" in order to find some basis for rejecting the claim based on Morris. The Court of Appeals for the Federal Circuit (CAFC) in many recent decisions has given guidance that during claim interpretation terms should be given their ordinary meaning. In the present application, the Applicants have described this ordinary meaning for the term "play list." Despite this, the Examiner has tried to redefine the term in a broader manner in order to find some suggestion in Morris of the expanded meaning. This cannot be supported under current case law.

Furthermore, no one skilled in the art would modify the teachings of Morris to use an application program (applet) operating a chat room as a play list. This is

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nonsensical. Morris' system is an instant messaging (IM) system, known and used by millions of AOL users. IM is an application program used to send short text messages between currently on-line users. IM is not a media player application such as Windows Media Player, RealPlayer, or WinAmp, that may operate according to a play list. A play list is a data structure, not an application program. The concepts of structure and operation of media players and play lists on one hand, and IM on the other, are very different. IM does not use play lists at all. One skilled in the art would not be motivated to modify an IM application to treat chat room sessions as play lists. The fact that a game can be played or a file can be transferred via an IM chat session teaches or suggests nothing about applying a dedication to a play list as claimed in claim 1.

For at least the above reasons, claim 1 is allowable as presented, as well as all claims dependent therefrom (i.e., claims 2-7). According to the same argument, claims 8-14, 15-20, and 21-26 are also allowable.

Additionally, with respect to claim 2, the Office action summarily rejects claim 2 on the basis of Morris, yet provides no discussion as to where the limitations of claim 2 are taught or suggest in Morris. Specifically, claim 2 recites the limitation of receiving a message and at least one insertion point from the first user, and applying the dedication and the message to the play list according to the at least one insertion point. The Office action of April 28, 2003 provides no real basis for rejecting this claim because it does not state where the limitations are taught or suggested in Morris. Specifically, there is no teaching or suggestion in Morris of the concept of insertion points into a play list. Therefore, claim 2 is allowable as presented.

Regarding claims 3-4, 5, and 7, these claims depend from allowable claim 1. Therefore, they are also allowable.

As to claims 8-9, they are allowable based on the above arguments for claims 1 and 2.

The Office action of April 28, 2003 provides no basis for rejecting claims 10-14. Without more, these claims are allowable since the Patent Office has not fulfilled its burden in providing a basis for rejection of the claims. In particular, Claim

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13 recites the limitation wherein an indication that the first user is online is received and that this causes the dedication to be applied to the play list that the first user is currently experiencing by transmitting the dedication to the network. That is, this means that the first user's current play list gets updated with the dedication, so that the first user subsequently hears or sees the dedication while on-line. Nowhere in Morris is such a concept taught or suggested. Furthermore, claim 14 recites the limitation that the message is to be applied to the play list as a voice over. That is, the message, if in text format, is converted to speech and played at the same time as the dedication in the play list. This is not taught or suggested by Morris. Claims 10-14 are allowable as presented.

As to claims 15-16, they are allowable based on the above arguments for claims 1 and 2.

As to claims 17-19, these claims depend from allowable claim 15. Therefore, they are also allowable.

Regarding claims 21-22, they are allowable based on the above arguments for claims 1 and 2.

As to claims 23-25, these claims depend from allowable claim 21. Therefore, they are also allowable.

Claims 6, 20, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable Morris in view of U.S. Pat. 6,539,354, issued to Sutton (hereinafter Sutton).

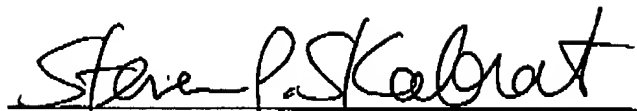
Claims 6, 20, and 26 depend from allowable independent claims 1, 15, and 21, respectively. Therefore, these claims are also allowable.

CONCLUSION

In view of the foregoing, Claims 1-28 are all in condition for allowance. If the Examiner has any questions, the Examiner is invited to contact the undersigned at (503) 264-8074. Early issuance of Notice of Allowance is respectfully requested.

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Respectfully submitted,

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Steven P. Skabrat
Senior Attorney
Intel Corporation
Registration No. 36,279
(503) 264-8074

c/o Blakely, Sokoloff, Taylor &
Zafman, LLP
12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1026

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